

proportions when drawings are not to scale. In fact, the Examiner has used Section 2125 of the M.P.E.P. as a reason to ignore the plain and clear disclosure contained in the drawings as filed.

Section 2125 of the M.P.E.P., has to do with the extent to which drawings in a patent may be utilized as prior art against claims in an application. That section of the M.P.E.P. has nothing to do with support in a specification as filed for subsequently added or amended claims in the context of a Section 112, first paragraph, objection and/or rejection.

Under a Section 112, first paragraph, analysis:

The fundamental factual inquiry is whether the specification conveys with reasonable clarity to those skilled in the art that, as of the filing date sought, applicant was in possession of the invention as now claimed. See, e.g., *Vas-Cath, Inc. v. Mahurkar*, 935 F.2<sup>nd</sup> 1555, 1563-64, 19 U.S.P.Q.2<sup>nd</sup> 1111, 1117 (Fed. Cir. 1991).

An applicant shows possession of a claimed invention by describing the claimed invention with all of its limitations using such descriptive means as words, structures, figures, diagrams, and formulas that fully set forth the claimed invention. *Lockheed v. American Airlines, Inc.*, 107 F.3d 1565, 1572, 41 U.S.P.Q.2<sup>nd</sup> 1961, 1966 (Fed. Cir. 1997). Further in this regard, the Examiner's attention is directed to Section 2163.02 of the M.P.E.P.

Turning to the limitation at issue here, there is no question but that one skilled in the art would recognize from the original text in paragraph 16 of page 4 of the application as filed, in conjunction with originally filed figures 3 and 4, that applicants were indeed in possession of an invention that included a core component with a slot extending from a lower end of the core upwardly more than half a height dimension of the core. This is not a minute limitation that requires close measurement or scrutiny. Rather, it is a proportion plainly apparent from the drawings as filed. Moreover, the Examiner has the initial burden of presenting evidence or reasoning to explain why a person skilled in the art would not recognize in the original disclosure

(which includes the drawings) a description of the invention as defined by the claims. *In re Wertheim*, 541 F.2d. 257, 191 U.S.P.Q. 90 (CCPA 1976). In the instant case, the Examiner has set forth no reasons why one skilled in the art would not understand applicant to have been in possession of the invention as described in amended paragraph 16 (and as now defined in amended claims 1 and 7).

For the above reasons, it is respectfully submitted that to the Examiner's position that the Amendment of April 13, 2005, introduced new matter into the disclosure is erroneous and should now be withdrawn.

The Examiner has rejected claims 1, 2 and 5-9 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The Examiner argues, consistent with the new matter objection, that the amended claims contain subject matter not described in the specification as filed, referring to the same core slot limitation noted above. Here again, the Examiner presents no reasons why one of ordinary skill in the art would not have understood that the applicant was in possession of the claimed invention, but rather simply cites Section 2125 of the M.P.E.P. As already noted, that section of the M.P.E.P. has to do with drawings used as prior art, and not drawings relied upon in support of a disclosed invention under 35 U.S.C. § 112, first paragraph. For essentially the same reasons, the Examiner is requested to withdraw this improper ground of rejection.

The Examiner has also rejected claims 1, 2, 5 and 6 under 35 U.S.C. § 103 as unpatentable over Obrochta; and claims 7-9, as unpatentable over Obrochta in view of the acknowledged prior art (paragraph 2 of the specification, as filed).


In neither of the above noted grounds of rejection has the Examiner considered the limitation added to independent claims 1 and 7 regarding the extent of the elongated core slot.

Accordingly, since the Section 112, first paragraph, ground of rejection has been shown to be improper, the prior art grounds of rejection must necessarily fail in that it is clear that the reference relied upon by the Examiner neither discloses nor suggests subject matter of independent claims 1 and 7 and claims dependent thereon.

Early passage of the subject application to issue (with remaining claims 1, 2 and 5-9) is requested, but in the event that any small matters remain outstanding, the Examiner is encouraged to telephone the undersigned so that the prosecution of this application can be expeditiously concluded.

Respectfully submitted,

**NIXON & VANDERHYE P.C.**

By:   
Michael J. Keenan  
Reg. No. 32,106

MJK:rrl  
901 North Glebe Road, 11th Floor  
Arlington, VA 22203-1808  
Telephone: (703) 816-4000  
Facsimile: (703) 816-4100